

REMARKS

Election

On November 22, 2004, the Examiner issued a restriction requirement asserting there to be two inventions present in the current application: Claim 1-30 for network communication between a user console and a host server and claims 31-73 drawn to a point rewarding system. In an election dated December 14, 2004, the Applicant “elect[ed] to proceed with examination of Group I (claims 1-30)” and “withdr[ew] the claims of Group II (claims 31-73) as being drawn to a non-elected invention, *with traverse.*” *December 14 Election*, 19. Applicant also presented an argument suggesting the Examiner’s restriction requirement was improper. While the Examiner failed to respond to the merits of the Applicant’s traverse, Applicant has (in order to expedite examination of the present application) cancelled claims 31-73.

Applicant’s cancellation of claims 31-73 should not be interpreted as accepting the grounds for the Examiner’s restriction, especially in light of the Examiner having failed to respond to the merits of the Applicant’s traverse. Nevertheless, the Applicant expressly reserves the right to pursue these claims through a continuing application.

Amendment to Title

Applicant has amended the title of the present application to better reflect the nature of the claims recited herein. That is, all claims in the present application are system claims. The Applicant has, therefore, amended the title to delete the recitation of ‘Apparatus and Method’ and replace the same with ‘System.’ Such an amendment is in accordance with 37 C.F.R. § 1.72 in that “[t]he title of the invention . . . must be as short and specific as possible.” The present amendment is not, however, intended to restrict the right of the Applicant to pursue additional claims (including non-system claims) in a later filed divisional or continuation application.

Rejections Under 35 U.S.C. § 102(e)

The Examiner has rejected claims 1-9 and 12-14 “under 35 U.S.C. 102(e) as being anticipated by Chatani et al.” *Office Action*, 2. The Applicant respectfully traverses.

Disc Storage Medium

With regard to independent claim 1, the Examiner, on page 2 at paragraph 5b of the *Office Action*, asserts U.S. Publication Number 2002/0104019 to Chatani et al. (hereinafter *Chatani*) to disclose a ‘disc storage medium.’ A ‘disc storage medium’ is recited in claim 1 of the present application wherein ‘[a] system for use in a network, compris[es] . . . a disc storage medium.’ Applicant notes, however, that the Examiner identifies **two differing elements** as purportedly anticipating the claimed ‘disc storage medium’—references 122 and 124 in Figure 1 of *Chatani*.

As an initial matter, the Applicant respectfully notes that “[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.” *In re Hoch*, 428 F.2d 1351, 1342 n.3 (CCPA (1970)). Further, Section 706.07 of the MPEP provides that “[b]efore final rejection is in order a clear issue should be developed between the examiner and the applicant.” To do so allows bringing “the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied.” MPEP § 706.07. The Examiner’s seemingly interchangeable rejection of the ‘disc storage medium’ makes it difficult to “attain[] the goal of reaching a clearly defined issue for an early termination.” MPEP § 706.07. Should further rejection of the present application be deemed necessary, the Applicant respectfully requests the Examiner further clarify this rejection prior to asserting the finality of any such rejection. Such clarification would comport with MPEP § 706.07 to provide “the applicant [with] a full and fair hearing” whereby “a clear issue between applicant and examiner may be developed.”

Reference 122 is identified (in Figure 1) as packaged storage media while reference 124 is identified as a memory card. The written description of *Chatani* characterizes reference 122 as “detachable storage media” that “stores a collection of interactive or non-interactive auxiliary content, such as computer games, movies, music clips, or advertisements, which can be made up of video images, animations, sounds, applets, and so on.” *Chatani* at [0023]. Reference 124, per the written description of *Chatani*, is characterized as “a memory card,” which “might be implemented as a proprietary card format, or a standard format device, such as PC/MCIA format or a similar card format.” *Chatani* at [0024]. Memory card 124 “stores various firmware parameters and operating environment data that are specific to the particular network game console.” *Chatani* at [0024].

Memory card 124 cannot anticipate claim 1 in that the memory card is clearly not a ‘disc storage medium.’ The *Background of the Invention* in the present application notes that CD-ROM and DVD-ROM are representative of ‘disc storage media.’ See *Specification* at [0003]. “During examination, ‘claims [of a pending application] are to be given their broadest reasonable interpretation consistent with the specification.’” *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (quoting *In re Bond*, 910 F.2d 831, 833 (Fed. Cir. 1990)). “This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification.” MPEP § 2111.01 (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)). The Applicant respectfully contends that for the Examiner to assert that a memory card anticipates a ‘disc storage medium’ would be to ignore the plain meaning of a ‘disc storage medium,’ in addition to countering any possible reasonable interpretation of the term, especially when considered in light of the specification.

Permanently Recorded Disc Identification

Assuming, *arguendo*, that memory card 124 constitutes the claimed ‘disc storage medium’—which Applicant contends it does not—the memory card does not include ‘permanently recorded disc identification’ as is required by claim 1. The Examiner

contends, on page 2 at paragraph 5b of the *Office Action*, that permanently recorded disc identification is disclosed in paragraph [0024] of *Chatani*. Paragraph [0024], however, pertains to “the identification number (ID) assigned to the particular **game console**.” *Chatani* at [0024] (emphasis added). This identification is not *disc* identification but, instead, **game console** identification. The Applicant further notes that the Examiner has not identified any teaching in *Chatani* with regard to the permanence of such identification as is also required by claim 1. As such, the Applicant contends that *Chatani*—as cited by the Examiner—fails to teach each and every limitation of claim 1 and the rejection is, therefore, overcome. See *Southwall Technologies, Inc. v. Cardinal, IG Co.*, 54 F.3d 1570, 1575 (Fed. Cir. 1995).

Disc Storage Medium Being Readable by the User Console

The Examiner, with regard to the limitation of ‘the disc storage medium being readable by the user console,’ departs from *Chatani*’s memory card 124 and now refers to packaged/detachable storage media 122 as “being readable by the user console.” *Office Action*, 2 at ¶ 5b. That is, the Examiner now contends media 122 to constitute the claimed ‘disc storage medium’ instead of the aforementioned memory card 124. Specifically, the Examiner cites that portion of *Chatani* that reads:

During normal operation, the networked game console 114 transfers data from the packaged storage media 122 onto the re-writeable storage media for temporary or medium term storage and execution. *Chatani* at [0023], l. 17-21.

Applicant notes in the portion of *Chatani* cited by the Examiner that in the context of the packaged storage media 122 having data transferred by the networked game console 114 that the Examiner has not identified ‘permanently recorded disc identification’ as is required by claim 1 of the present application. While the Examiner previously asserted an “identification number (ID) assigned to [a] particular game console” (*Chatani* at [0024]) as anticipating this particular claim limitation, Applicant notes that ID to: (1) have been identified by the Examiner in the context of memory card

124; (2) to actually be related to a game console and not a memory card or disc; and (3) the Examiner not to have identified teaching of permanence. As such, the Examiner has not identified in *Chatani* any teaching of 'a disc storage medium including a permanently recorded disc identification, the disc storage medium being readable by the user console.' As such, *Chatani*—as cited by the Examiner—fails to teach each and every limitation of claim 1 and the rejection is, therefore, overcome. See *Southwall*, 54 F.3d at 1575.

User Console Operable to Transmit the Disc Identification Over the Network

The Examiner further contends *Chatani* to teach a "user console operable to transmit the disc identification over the network." *Office Action*, 2 at ¶ 5b. The Examiner refers to the following portion of *Chatani* as purportedly teaching this limitation:

In step 310, the Interactive Computer System encrypts the ID number of the software title to be rented into the user public key. The Interactive Computer Entertainment System also encrypts the memory card public key into the user public key. In one embodiment, the memory card public key is created based on the information stored in the memory card and is programmed into the memory card that is inserted into the Interactive Computer Entertainment System upon use. The Interactive Computer Entertainment System then displays this encrypted information on the screen of a display device coupled to the system, step 312. *Chatani* at [0043], l. 13-24.

The Applicant presumes the Examiner is now referring to a previously unidentified Interactive Computer Entertainment System (ICES) as disclosing Applicant's claimed 'user console.' If this is the Examiner's intention, then the Applicant respectfully suggests that the Examiner is ignoring the antecedent relationship between the various claim elements in Applicant's claim 1.

For example, claim 1 recites 'a user console . . . the disc storage medium being readable by the user console.' In the *Office Action*, the Examiner initially identifies reference 114—"a networked game console"—as purportedly anticipating this limitation. *Office Action*, 2 at ¶ 5a; see also *Chatani* at [0022]. The Examiner refers to that

same networked game console (114) with regard to reading the disc storage medium. But claim 1 requires that the same user console be 'operable to transmit the disc identification over the network.' That is, the Examiner assertion of anticipation of claim 1 cannot be based on a second user console such as the ICES (if the Examiner asserts the ICES to constitute such a console) for transmitting the disc identification; it must be the same console.

The Examiner further disregards the antecedent relationship of the claimed 'disc identification.' The Examiner initially identified the "the identification number (ID) assigned to the particular game console" as anticipating the claimed 'disc identification.' *Chatani* at [0024]. The Examiner now, however, refers to a previously unidentified "ID number of the software title to be rented." *Chatani* at [0043]. Not only has the Examiner disregarded the previous elements of *Chatani* that were asserted as allegedly anticipating Applicant's present claims, but the present reference also fails to anticipate in that the present reference is to an ID number of software and not disc identification. That is, the Examiner refers to content (software) instead of media (disc).

Finally, there is no network for achieving the purported transmission in the portions of *Chatani* as identified by the Examiner. While *Chatani* does reference a "bi-directional network," (108) the Examiner has not identified that the disc identification is transmitted over this network. For example, paragraph [0043] of *Chatani* as referenced by the Examiner is referring to the steps reflected in Figure 3. Figure 3, however, "is a flowchart that illustrates the steps of distributing a limited use software product for an off-line distribution embodiment." *Chatani* at [0012] (emphasis added).

The Examiner's reference to steps 224-228 in Figure 2B is, respectfully, without merit in that the Examiner has failed to show any relationship between the steps of Figures 2B and 3. Figure 2B, in fact, refers to "an encryption/decryption process." *Chatani* at [0032]. As evidenced by *Chatani* in paragraphs [0032-0036], a process for generating a public key and private key pair is disclosed. The Examiner has not identified a teaching with regard to the transmission of a 'disc identification over [a] network.'

Finally, with regard to the Examiner's reference to a 'step 224,' the Examiner has not provided any support that reference 224 is the 'disc identification' as claimed in the present application. If the Examiner contends 'user info' to constitute Applicant's claimed 'disc identification,' then the Examiner has failed to reconcile with those previous references utilized by the Examiner as purportedly evidencing 'a disc storage medium including a permanently recorded disc identification.' As such, *Chatani*—as cited by the Examiner—fails to teach each and every limitation of claim 1; the rejection is, therefore, overcome. See *Southwall*, 54 F.3d at 1575.

Claims 2-9 and 12-14 depend from claim 1 either directly or via an intermediate dependent claim. As a dependent claim "shall be construed to incorporate by reference all the limitations of the claim to which it refers," dependent claims 2-9 and 12-14 are not anticipated by *Chatani*, *Chatani* failing to anticipate base claim 1. Furthermore, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. See *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Therefore, dependent claims 2-9 and 12-14 are non-obvious and also allowable over the cited references.

*Rejections Under 35 U.S.C. § 103(a)
and Applicability of 35 U.S.C. § 103(c)*

The Examiner rejected claims 15-16 and 19-22 "under 35 U.S.C. § 103(a) as being unpatentable over Chatani in views (sic) of Clenaghan et al." *Office Action*, 5 at ¶ 18. The Applicant hereby informs the Examiner of the common ownership of the *Chatani* reference and the present application. That is, the *Chatani* reference and the present application are both assigned to Sony Computer Entertainment America Inc. as reflected by the assignments recorded at Reel 011852, Frame 0405 and Reel 011948, Frame 0654, respectively.

As *Chatani* is a reference only for the purposes 35 U.S.C. § 102(e), Applicant notes the applicability of 35 U.S.C. § 103(c). Section 103(c) provides, *inter alia*, that when a reference "qualifies as prior art only under [subsection(e)] of section 102," that reference

"shall not preclude patentability . . . where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." In light of 35 U.S.C. § 103(c), Applicant's representative hereby states as follows:

The subject matter of the *Chatani* reference and the presently claimed invention were, at the time invention was made, owned by and/or under an obligation to assign to the same entity: Sony Computer Entertainment America Inc.

See MPEP § 706.02(I)(3) (concerning sufficiency of this statement in establishing common ownership for the purposes of Section 103(c)). The Applicant further notes that applications and references should be considered by the examiner to be owned by, or subject to an obligation to assign, at the time the invention was made, if the applicant or their attorney makes a statement to this effect. See *Guidelines Setting Forth a Modified Policy Concerning the Evidence of Common Ownership, or an Obligation of Assignment to the Same Person, as Required by 35 U.S.C. 103(c)*, 1241 O.G. 96 (Dec. 26, 2000).

In accordance with 35 U.S.C. § 103(c), the *Chatani* reference is disqualified as a reference for the purposes of an obviousness rejection under 35 U.S.C. § 103(a) and the Applicant, therefore, contends the Examiner's rejection of claims 15-16 and 19-22 (*Chatani* + *Clenaghan*) to have been overcome.

The Examiner also rejected claims 10-11, 17-18 and 23-30 "under 35 U.S.C. § 103(a) as being unpatentable over Chatani in views (sic) of Clenaghan and in further views (sic) of Matsuo e al." *Office Action*, 7 at ¶ 25. As noted in the context of *Clenaghan*, the *Chatani* reference is disqualified as a reference for the purposes of an obviousness rejection under 35 U.S.C. § 103(a) and the Applicant, therefore, contends the Examiner's rejection of claims 10-11, 17-18 and 23-30 (*Chatani* + *Clenaghan* + *Matsuo*) to also have been overcome.

CONCLUSION

Applicant has evidenced the failure of *Chatani* to anticipate each and every limitation of claim 1. As such, claim 1 is allowable over the cited prior art. All claims depending from claim 1 (*i.e.*, claims 2-30) are also allowable.

Applicant has also evidenced the applicability of 35 U.S.C. § 103(c) as it pertains to the *Chatani* reference. Therefore, claims 10-11, 15-30, for which the Examiner utilizes *Chatani* as a base reference for a rejection under 35 U.S.C. § 103(a), are allowable in their own right.

Based on the foregoing remarks, Applicant respectfully requests the Examiner issue a *Notice of Allowance* for the present application. If the Examiner has any questions concerning the present response, the Examiner is invited to contact Applicant's undersigned representative at the number given below.

Respectfully submitted,
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